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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,844	12/09/2003	Robert W. King	410027-32	5229

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Fulwider Patton Lee & Utecht LLP  
Atten: Alan C. Rose  
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Los Angeles, CA 90045

EXAMINER
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KING, ANITA M

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/730,844

Applicant(s)

KING, ROBERT W.

Examiner

Anita M. King

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/13/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

This is the second office action for application number 10/730,844, Simplified Pipe Support Assembly, filed on December 9, 2003.

### ***Claim Objections***

Claim 8 is objected to because of the following informality: in line 9, "snap-in" should be changed to --snap-on--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is an inconsistency in claim 8, wherein it is uncertain if elements are intended to be limitations of the claimed invention. The language of claim 8 would lead the examiner to believe that the applicant intends to claim only the subcombination of "a support or fitting," the pipe being only functionally recited.

The problem arises when the pipe is positively recited within the body of the claim, such as, "the space between said jaws being slightly less than said outer diameter." There is an inconsistency within the claim; the preamble indicates subcombination, while in at least one instance in the body of the claim there is a positive recital of structure indicating that the combination of a support or fitting and a pipe are

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being claimed. The examiner cannot be sure if applicant's intent is to claim merely the support or fitting or the pipe in combination with the support or fitting.

In formulating a rejection on the merits, the examiner is considering that the claims are drawn to the subcombination and the claims will be rejected accordingly. If applicant indicates by amendment that the combination claim is the intention, the language in the preamble should be made consistent with the language in the body of the claims. If the intent is to claim the subcombination, then the body of the claims must be amended to remove positive recitation of the combination.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4, 6, 7, 11-14, and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,543,731 to Mercier in view of U.S. Patent D408,273 to Senninger and in further view of U.S. Patent D417,141 to Senninger, hereinafter, Senninger '141. Mercier discloses a system for mounting plastic pipes, comprising: a hollow plastic support pipe (16) having an outer diameter; first and second plastic fittings each including a base portion (19) having openings for receiving screws or nails, and an integral partially open portion (18) for receiving the hollow plastic support pipe; a double plastic clip fitting (21) having a first tubular portion (22) for mounting on the hollow plastic support pipe, and a second integral, partially open, snap-on clip portion (23) for receiving a fluid flow system pipe (11); and the snap-on clip portions (23) being

partially open and having outwardly extending jaws, the space between the jaws having an extent slightly less than the outer diameter of the fluid flow system pipe; whereby the support pipe may be cut to a length slightly less than the distance between two studs (13), the base portion (19) of the fittings may be secured in place on the studs, the support pipe positioned in the open portion, and the clip fitting snapped onto the fluid flow system pipe to simply and securely hold the fluid flow system pipe in place; wherein at least one of the pipes is bonded to one of the clips by plastic solvent (Col. 2, line 4ff); wherein the pipes and fittings are formed of PVC (Col. 2., line 5); wherein the open space between the jaws are of a predetermined value; and wherein the axial extent of the jaws is greater than the outer diameter of the fluid pipe.

Mercier discloses the claimed invention except for the limitation of first and second snap fittings. Senninger teaches that it is known to have a snap fitting having a base portion including a openings for receiving a nail or screw and an integral open snap-on clip portion for receiving a pipe. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the fittings in Mercier to have included the fitting as taught by Senninger for the purpose of providing an alternative, mechanically equivalent fitting for supporting the hollow plastic support pipe between a pair of studs and for providing a fitting wherein the hollow plastic support pipe is readily and easily removable from between the studs.

Mercier combined with Senninger disclose the claimed invention except for the limitation of a double snap-on plastic clip fitting. Senninger '141 teaches that it is known to have a double snap-on plastic clip fitting having a first partially open snap-on clip

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portion for receiving a pipe and a second integral, partially open, snap-on clip portion arranged non-parallel to the first partially open snap-on clip portion for receiving another pipe. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the system in Mercier combined with Senninger to have included the double snap-on plastic clip fitting as taught by Senninger '141 for the purpose of providing a fitting that it easily attached and removed from plural supported/supporting objects.

Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mercier combined with Senninger and Senninger '141 and in further view of U.S. Patent 5,288,047 to Pan. Mercier combined with Senninger and Senninger '141 disclose the claimed invention except for the limitation of the two snap-on clip portions of the double fitting are of different sizes. Pan teaches a double snap-on plastic clip (1) having a first partially open snap-on clip portion (11) and a second integral, partially open, snap-on clip portion (12), and wherein the two snap-on clip portions of the double fitting are of different sizes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the snap-on plastic clip in Mercier combined with Senninger and Senninger '141 to have included a double snap-on plastic clip as taught by Pan for the purpose of providing a fitting that it easily attached and removed from plural supported/supporting objects having different diameters. It would have been obvious to one having ordinary skill in the art to have the space and the axial extent of the jaws to have been about three-quarters of the diameter of the pipe and greater than one-half the diameter, respectively, for the purpose of providing an

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aesthetically different support and since such a modification would not have produced any unexpected results.

Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Senninger. Senninger discloses a support or fitting comprising a base portion having holes there through for receiving nails or screws, a snap-on clip portion of generally circular configuration for receiving a pipe having a predetermined outer diameter; the snap-on portion being partially open and having outwardly extending U-shaped jaws; the space between the jaws being slightly less than the outer diameter; the base portion of the snap-on clip portion being integrally molded. Senninger discloses the claimed invention except for the limitations of the support being plastic and the space between the jaws being about three-quarters or one-half the outer diameter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the support in Senninger to have been plastic since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Senninger discloses the claimed invention except for limitation of the space between the jaws being about three-quarters or one-half of the outer diameter. It would have been an obvious to have modified the spacing between the jaws in Senninger to have been a certain dimension for the purpose of accommodating a pipe having a predetermined diameter and, since such a modification would have involved a mere

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change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

### ***Response to Arguments***

Applicant's arguments filed August 13, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Mercier teaches a clip having a portion for surrounding a pipe and a clip portion for snapping onto another pipe, it would have been obvious to one having ordinary skill in the art to modify the first portion to be similar to the second portion (clip-on portion) for the purposes of easily assembling and disassembling the system without having to remove the hollow pipe from the fittings. Pan teaches that it is known to have a double snap-on clip for receiving and supporting two opposing cylindrical members.

In response to applicant's argument that Pan is as a connector for decorative light bulbs, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to



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patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent D227,742 to Logsdon

U.S. Patent 5,943,985 to Hartman

Logsdon discloses a joist hanger having a base portion and a snap-on clip portion.


Hartman discloses a welded bracket for supporting a plurality of cylindrical members.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anita M. King whose telephone number is (703) 308-2162. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie A. Braun can be reached on (703) 308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anita M. King  
Primary Examiner  
Art Unit 3632

October 26, 2004